

**REMARKS**

In the Final Office Action<sup>1</sup>, the Examiner rejected claims 1-10, 16-20, and 23-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,890,135 to Powell ("*Powell*") in view of European Patent No. 0 917 119 A2 to Paltenghe et al. ("*Paltenghe*"); rejected claims 21 and 22 under 35 U.S.C. § 103(a) as unpatentable over *Powell*, in view of *Paltenghe*, and further in view of U.S. Patent No. 6,167,383 to Henson ("*Henson*"); and rejected claims 11-15 under 35 U.S.C. § 103(a) as unpatentable over *Powell*, in view of *Paltenghe*, and further in view of U.S. Patent No. 5,774,870 to Storey ("*Storey*").

Applicants have amended claims 1 and 23-33. Claims 1-33 remain pending in this application.

**I. Regarding the rejection of claims 1-10, 16-20, and 23-33 under 35 U.S.C. § 103(a) as being unpatentable over *Powell* in view of *Paltenghe***

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-10, 16-20, and 23-33 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In*

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

*re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P.  
§ 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Powell* nor *Paltenghe*, alone or in any proper combination, teach each and every element of Applicants' claims.

Claim 1 recites a combination including, for example:

an information distribution apparatus associated with a purchase information trader, including:

...

a use log counting unit configured to count the use record for a store which makes a contract with the purchase information trader for distribution of coupon information, and to output a request of charge of distribution based on the counted result;

wherein said first communication unit sends the request of charge to a sales apparatus of the store,

...

the sales apparatus located at the store, including:

a third communication unit coupled to a wireless connection;

...

wherein said third communication unit receives the request of charge from said information distribution apparatus.

(emphasis added). *Powell* does not teach or suggest at least these elements.

*Powell* teaches a computer network 1020 that "stores electronic coupons and distributes the stored coupons to the homes" (col. 3, lines 48-50). A computer in the customer's home receives the coupons from the computer network 1020 and stores the coupons on a portable card 295 (col. 3, lines 52-55). The customer shops at a store and "completes the purchase of her selected products 293 by transferring products 293 from her cart 292 to counter 900, and by inserting the card 295 into checkout station 915" (col. 7, lines 14-17). A processor, coupled to station 915, and reader 910 determine "whether the most recently scanned product is on a discount list stored in

card 295” (col. 7, lines 21-23). “Checkout counter 900 scans and processes each product 293 in a similar manner” and, periodically, “checkout counter 900 sends redemption data to an electronic clearing house” (col. 7, lines 27-28 and 40-41).

The Examiner states that computer network 1020 of *Powell* corresponds to the claimed information distribution apparatus, and the portable cards 285, 295, and 315 of *Powell* correspond to the claimed terminal unit (Office Action at page 3). It is unclear if the Examiner relies on the checkout counter 900 and the associated processor and reader, or the electronic clearing house that receives redemption data, to teach the claimed sales apparatus, located at the store, that includes a third communication unit. Therefore, Applicants will address each possibility.

Assuming that the checkout counter 900 and the associated processor and reader allegedly teach the claimed sales apparatus located at the store, there is no teaching, in *Powell*, that the computer network 1020 sends a request of charge to the checkout counter 900 and the associated processor and reader. Rather, the computer network 1020 only communicates with homes 1025, 1030, and 1035 via telephone signal paths 180 (col. 3, lines 49-51 and Fig. 1). In addition, there is no teaching that the checkout counter 900 and the associated processor and reader receive a request of charge from the computer network 1020. Therefore, the checkout counter 900 and the associated processor and reader of *Powell* do not constitute “an information distribution apparatus...including...a first communication unit...wherein said first communication unit sends the request of charge to a sale apparatus of the store...and the sales located in the store, including a third communication unit...wherein said third communication

unit receives the request of charge from said information distribution apparatus,” as recited in claim 1.

Addressing the other alternative, assuming that the electronic clearing house allegedly teaches the claimed sales apparatus located at the store, there is no teaching, in *Powell*, that the electronic clearing house receives a request of charge from the computer network 1020. The computer network 1020 only communicates with homes 1025, 1030, and 1035, and does not communicate with the store or the electronic clearing house. Furthermore, “the checkout counter 900 sends redemption data to an electronic clearing house” (col. 7, lines 40-41). In *Powell*, only the checkout counter communicates with the electronic clearing house. In addition, the electronic clearing house is not located in the store 1000. The clearing house is separate from the store, and “redemption data sent to the clearing house includes identification of the store...” (col. 7, lines 41-42). Therefore, the electronic clearing house does not constitute the claimed third communication unit at least because the electronic clearing house does not receive a “request of charge from said information distribution apparatus” and is not included in a “sales apparatus located at the store,” as recited in claim 1.

*Paltenghe* does not cure the deficiencies of *Powell*. *Paltenghe* teaches a system “for the selective organization, access to and use of personal data” (paragraph 0010). *Paltenghe* does not teach “an information distribution apparatus...including...a first communication unit...wherein said first communication unit sends the request of charge to a sale apparatus of the store...and the sales located in the store, including a third communication unit...wherein said third communication unit receives the request of charge from said information distribution apparatus,” as recited in claim 1.

Because the cited references fail to teach or suggest each and every claim element recited by claim 1, no *prima facie* case has been established with respect to these claims. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 1-10, 16-20, and 23 under 35 U.S.C. § 103(a) as being unpatentable over *Powell* in view of *Paltenghe*.

Claims 2-10, 16-20, and 23 are also allowable at least due to their dependence from claim 1.

Independent claims 24-33, although of different scope from claim 1 and from each other, recite limitations similar to claim 1, which are also not taught by the cited references. Accordingly, no *prima facie* case of obviousness has been established for claims 24-33 for at least the reasons set forth above with respect to claim 1. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 24-33 under 35 U.S.C. § 103(a) as being unpatentable over *Powell* in view of *Paltenghe*.

**II. Regarding the rejection of claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Powell* in view of *Paltenghe* and further in view of *Henson***

Claims 21 and 22 depend from claim 1 and therefore include all of the elements recited in claim 1. As discussed above, *Powell* and *Paltenghe* fail to teach or suggest each and every element recited by claim 1 and required by claims 21 and 22.

The Examiner relies on *Henson* for allegedly teaching “receiving user feedback (selections) and analyzing such feedback to select information to provide to the user” (Office Action at p. 9). Even assuming this characterization is correct, *Henson* fails to cure the deficiencies of *Powell* and *Paltenghe* discussed above. That is, *Henson* also

fails to teach or suggest a settlement system including “a first communication unit,” “a sales apparatus” at a store, and “an information distribution apparatus,”

wherein said first communication unit sends the request of charge to a sales apparatus of the store,

...

the sales apparatus located at the store, including:

a third communication unit coupled to a wireless connection;

...

wherein said third communication unit receives the request of charge from said information distribution apparatus.

as required by claims 21 and 22.

Because neither *Powell*, *Paltenghe*, nor *Henson*, taken alone or in combination, teach or suggest each and every element required by dependent claims 21 and 22, no *prima facie* case of obviousness has been established with respect to these claims. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Powell*, in view of *Paltenghe*, and further in view of *Henson*.

**III. Regarding the rejection of claims 11-15 under 35 U.S.C. § 103(a) as being unpatentable over *Powell* in view of *Paltenghe* and further in view of *Storey***

Claims 11-15 depend from claim 1 and therefore include all of the elements recited in claim 1. As discussed above, *Powell* and *Paltenghe* fail to teach or suggest each and every element recited by claim 1 and required by claims 11-15.

The Examiner relies on *Storey* for allegedly teaching “promotional information pertaining to games or coupons” (Office Action at p. 10). Even assuming this characterization is correct, *Storey* fails to cure the deficiencies of *Powell* and *Paltenghe* discussed above. That is, *Storey* also fails to teach or suggest a settlement system

including “a first communication unit,” “a sales apparatus” at a store, and “an information distribution apparatus,”

wherein said first communication unit sends the request of charge to a sales apparatus of the store,

...

the sales apparatus located at the store, including:

a third communication unit coupled to a wireless connection;

...

wherein said third communication unit receives the request of charge from said information distribution apparatus.

as required by claims 11-15.

Because neither *Powell*, *Paltenghe* nor *Storey*, taken alone or in combination, teach or suggest each and every element required by dependent claims 11-15, no *prima facie* case of obviousness has been established with respect to these claims.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 11-15 under 35 U.S.C. § 103(a) as being unpatentable over *Powell*, in view of *Paltenghe*, and further in view of *Storey*.

#### **IV. Conclusion**

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-33 in condition for allowance. Applicants submit that the proposed amendments of claims 1 and 23-33 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 26, 2006

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